

REMARKS

Applicant has reviewed the Office Action dated April 15, 2003, and the references cited therewith.

Claim 13 is amended; as a result, claims 2, 6, 8-11, 13-15, 23-26 and 30 are now pending in this application.

§112 Rejection of the Claims

In the Office Action, claim 13 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

An amendment to claim 13 has been proposed to provide the antecedent basis. The amendment is for clarification only and is non-narrowing. Entry of the amendment, and reconsideration and withdrawal of the rejection are respectfully requested.

§103 Rejection of the Claims

In the Office Action, claims 2, 6, 8 – 11, 13, 14 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Brownlee et al. (U.S. Patent No. 4,134,408) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Renken (U.S. Patent No. 6,009,350).

Claim 15:

Applicant respectfully traverses the rejection to claim 15. The Office Action fails to make out a proper *prima facie* case of obviousness because the proposed combination does not include all the limitations of claim 15.

Applicant is unable to find in the referenced documents, among other things, where there is a disclosure of a telemetry coil having a “plurality of loops of a conductive wire wound substantially in a common plane and concentrically around a central core, . . . , and where the loops are positioned around the central core to form a substantially constant gap between adjacent loops,” as recited in claim 15.

In contrast, the cited portions of the references do not describe a telemetry coil where the windings are wound in a common plane. In particular, while ¶ 3 of the Office Action states that Brownlee describes the invention except for the magnetically permeable core and the loops

around the core being positioned to form a substantially constant gap between adjacent loops, Applicant is unable to find such a description of a physical arrangement of telemetry coil windings in either Brownlee or Silvian.

Further, Applicant is unable to find a description of windings with “a substantially constant gap between adjacent loops” in Renken. The cited portion of Renken describes multiple coils spaced equally apart from each other. Thus, the “constant gap” the Office Action attributed to Renken is a gap between non-concentric placements of multiple coils and does not describe the “plurality of loops of a conductive wire wound . . . concentrically around a central core, . . . , and where the loops are positioned around the central core to form a substantially constant gap between adjacent loops,” recited in claim 15. Neither can Applicant find in the cited portions of Renken, a discussion of windings “wound substantially in a common plane.” Therefore, the proposed combination of Renken with Brownlee and Silvian does not include all the limitations of claim 15.

Applicant respectfully requests reconsideration and allowance of claim 15.

Claims 2, 6, 8-11, 13 and 14:

Applicant respectfully traverses the rejection to the claims.

Claims 2, 6, 8-11, 13 and 14 ultimately depend on claim 15 and are believed to be allowable at least for the reasons stated for that claim.

Also, the Office Action states that an external telemetry coil housed within a chair or bed as described in the proposed combination, and specifically in Brownlee, reads on the flexible housing encasing the telemetry coil recited in claim 2, the conformable flexible housing recited in claim 8, the insulating flexible housing recited in claim 9, a flexible housing retaining a formed shape recited in claim 10, the flexible housing containing two concentric coils in claim 13, and the padded cover over the flexible housing in claim 14. The Office Action appears to state that while Brownlee does not expressly describe the various flexible housings claimed in the present application, that such housings are inherent in a telemetry coil mounted within a chair or bed.

Applicant respectfully disagrees because the Office Action has not established a *prima facie* case of inherency because the Office Action must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics of

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

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the several claims necessarily flow from the descriptions in the proposed combination of documents. Applicant respectfully submits that the subject matter of claims 2, 6, 8-11, 13 and 14 is not inherent in a telemetry coil mounted within a chair or bed.

Applicant respectfully requests reconsideration and allowance of claims 2, 6, 8-11, 13 and 14.

In the Office Action, claim 23 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Renken (U.S. Patent No. 6,009,350).

Applicant respectfully traverses the rejection. The Office Action fails to make out proper *prima facie* obviousness because the proposed combination does not include all the limitations of claim 23.

Applicant is unable to find, among other things, in the proposed combination of documents, where “the conductive loops are positioned around the central core to form a substantially constant gap between adjacent loops,” as recited in claim 23.

The Office Action stated that this subject matter of claim 23 is described in Renken. However, the cited portion of Renken describes multiple telemetry coils spaced equally apart from each other. Thus, the constant gap the Office Action attributed to Renken is a gap between non-concentric placements of multiple telemetry coils, and not a “first and second telemetry coil ... concentrically planarly wound substantially in a common plane, ... , whre the conductive loops are positioned around the central core to form a substantially constant gap between adjacent loops” recited in claim 23.

Applicant respectfully requests reconsideration and allowance of claim 23.

In the Office Action, claim 24 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Renken (U.S. Patent No. 6,009,350) and further in view of Kung (U.S. Patent No. 6,400,991), and claims 25 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No.

6,301,504) and further in view of Renken (U. S. Patent No. 6,009,350) and further in view of Zarinetchi et al. (U.S. Patent No. 6,389,318).

Applicant respectfully traverses the rejections. Claims 24-26 ultimately depend on claim 23 and are believed to be allowable at least for the reasons stated for claim 23. Applicant requests reconsideration and allowance of claims 24-26.

In the Office Action, claim 30 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Snell et al. (U.S. Patent No. 6,424,867).

Applicant respectfully traverses the rejection. The Office Action fails to make out proper *prima facie* obviousness because the proposed combination of documents does not include all the limitations of claim 30. Applicant is unable to find in the cited portions of the documents where the second telemetry coil is constructed and arranged to operate at a different telemetry operational frequency than the first telemetry coil, as recited in part in claim 30.

Specifically, Applicant disagrees with the assertion in the Office Action that the cited portions of Snell describe a system with two telemetry operational frequencies. The cited portions of Snell describe a telemetry system capable of using different protocols (see Col. 3 lines 40-47). The term “protocol” as used in Snell is defined in Col. 3 lines 47-53 as different encoding schemes, data transmission rates, or different access codes. In contrast, operational frequency describes the frequency to which a telemetry antenna is tuned. An external telemetry coil ringing at the tuned frequency causes ringing in a coil in the implanted device if the implanted coil is tuned to the same frequency. This tuning involves designing the coils to an inductance and resistance rather than defining bits in a protocol as in Snell. Thus, in making the rejection by reading the term “protocol” as “operational frequency,” the Office Action does not use a definition of protocol consistent with the specification of Snell. Applicant respectfully requests reconsideration and allowance of claim 30.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 612-373-6970 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MARK D. AMUNDSON ET AL.

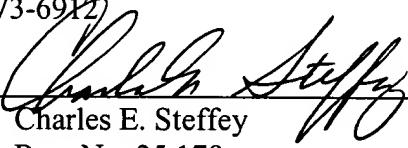
By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
612-373-6912

Date

July 19, 2003

By


Charles E. Steffey
Reg. No. 25,179

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 18th day of July, 2003

Name

Dawn M. Poole

Signature

Dawn M. Poole